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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,508

07/11/2003

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01/30/2009

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EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

01/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/617,508	Applicant(s) MCLAUGHLIN, GREGORY	
	Examiner DANIEL LASTRA	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-18 have been examined. Application 10/617,508 (METHOD OF PROVIDING CUSTOMIZED COUPON CARDS) has a filing date 07/11/2003.

Response to Amendment

2. In response to Non Final Rejection filed 12/31/2007, the Applicant filed an Amendment on 07/02/2008, which amended claims 3, 4.

Claim Objections

3. Claim 13 is objected to because it is not identified as amended or not.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 11-14, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Sheddan (US 2002/0194088).

Claim 1, Sheddan teaches:

A method of providing a customized compilation of discount purchase offers to a user, the method comprising the steps of:

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a) collecting one or more discount purchase offers from a merchant (see paragraphs 28, 31);

b) assimilating the collected discount purchase offers into an offer database (see paragraph 28);

c) allowing the user to select one or more desired offers from the offer database (see paragraph 28);

d) allowing the user to select a medium for display and storage of the compilation of discount purchase offers (see paragraphs 28-30);

e) delivering the customized compilation of discount purchase offers, as embedded upon the selected medium, to the user (see paragraph 30).

Claim 2, Sheddán teaches:

wherein the desired offers are categorized (see paragraph 28).

Claim 3, Sheddán teaches:

wherein the collected discount purchase offers may be assimilated by a marketing subcontractor (see paragraph 24 “school”).

Claim 4, Sheddán teaches:

wherein the collected discount purchase offers may be assimilated by a coupon card distribution company (see paragraph 24 “restaurant”).

Claim 5, Sheddán teaches:

wherein the user is a local or national merchant (see paragraph 24).

Claim 6, Sheddán teaches:

wherein the user is a licensee (see paragraph 33 “register user”).

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Claim 7, Sheddan teaches:

wherein the user is a franchisee (see paragraph 33 “organization”).

Claim 8, Sheddan teaches:

wherein the user is a local or national fundraising organization (see paragraph 7).

Claim 11, Sheddan teaches:

wherein the medium for display and storage of the compilation of discount purchase offers is a coupon book (see paragraph 26).

Claim 12, Sheddan teaches:

wherein the medium for display and storage of the compilation of discount purchase offers is an electronic memory storage device (see paragraph 30).

Claim 13, Sheddan teaches:

A method of providing customized coupon cards to a user via a graphical user interface, the method comprising the steps of:

- a) prompting the user to log on to a website (see paragraph 33);
- b) prompting the user to enter a regional indicator (see paragraphs 25, 37);
- c) prompting the user to select a card medium (see paragraphs 28-30);
- d) displaying a plurality of discount purchase offers from national and local merchants that the user will be able to choose from (see paragraphs 28, 31);
- e) prompting the user to select one or more discount purchase offers (see paragraph 28);
- f) displaying pricing information corresponding to the discount purchase offers selected (see paragraph 28);

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- g) prompting the user to select a card design (see paragraph 29);
- h) displaying a preview of the offers and card design selected (see paragraph 29);
- i) displaying an overview of the offers and card design selected (see paragraph 30);
- j) prompting the user to select a form of delivery (see paragraph 26);
- k) prompting a user to select a form of payment (see paragraphs 24, 30);
- l) displaying a confirmation of payment received (see paragraphs 26, 30); and
- m) delivering the selected offers and card design to the user (see paragraph 27).

Claim 14, Sheddan teaches:

wherein the national and local merchants' offers may be automatically alphabetized and categorized in a format selected by the user (see paragraph 28).

Claim 17, Sheddan teaches:

wherein the card medium is a coupon book (see paragraph 9).

Claim 18, Sheddan teaches:

wherein the card medium is an electronic memory storage device (see paragraph 30).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shedd (US 2002/0194088) in view of Long (US 6,572,149).

Claims 9 and 15, Shedd does not expressly teach:

wherein the medium for display and storage of the compilation of discount purchase offers is a cardstock multi-fold card. However, Long teaches that it is old and well known in the promotion art to provide customers with a compilation of coupons offers in a multi-fold card stock (see figure1; col 2, lines 39-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Shedd would compile coupon offers in multi-fold card stocks, as it is old and well known to do so, as taught by Long.

Claims 10 and 16, Shedd does not expressly teach wherein the medium for display and storage of the compilation of discount purchase offers is a plastic card. However, Long teaches that it is old and well known in the promotion art to provide customers with a compilation of coupons offers in plastic card stock (see figure1; col 2, lines 39-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Shedd would compile coupon offers in plastic card stocks, as it is old and well known to do so, as taught by Long.

Response to Arguments

6. Applicant's arguments filed 07/02/2008 have been fully considered but they are not persuasive. The Applicant argues that Shedd does not teach selecting between a

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plastic card, multi-ford card and other media. The Examiner answers that he used Long to teach said limitation. Therefore, contrary to Applicant's argument, the prior arts teach Applicant's claimed limitation.

The Applicant argues that the prior arts do not teach a marketing subcontractor. The Examiner answers that Sheddan teaches that a participant in Sheddan can provide offers and also can function as a user (see paragraph 24). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach a coupon card distribution company. The Examiner answers that Sheddan teaches merchants distributing coupons (see paragraph 24). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed invention.

The Applicant argues that Sheddan does not teach a user as a local or national merchant. The Examiner answers that Sheddan teaches merchants as users distributing coupons (see paragraph 24). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed invention.

The Applicant argues that Sheddan does not teach a register user. The Examiner answers that Sheddan teaches a user log ID and password (see paragraph 33). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach a user. The Examiner answers that in Sheddan a user is the one who customize a compilation of discount

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offers (see paragraph 38). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach fundraising organization as a user. The Examiner answers that Sheddan teaches a school selling coupon book to raise funds (see paragraph 24). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach "prompting the user to select a card medium". The Examiner answers that Sheddan teaches allowing a user to select a coupon book as media to print coupon offers (see paragraph 38). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed invention.

The Applicant argues that Sheddan does not teach "prompting the user to select one or more discounts purchase offers". The Examiner answers that Sheddan teaches allowing a user to select offers to include in a coupon book (see paragraph 38). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach displaying pricing information. The Examiner answers that Sheddan teaches displaying billing information (see paragraph 40). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach displaying preview offers. The Examiner answers that Sheddan teaches displaying review of the data (see

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paragraph 30). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach prompting a user to select a form of payment. The Examiner answers that Sheddan teaches entering any necessary ordering and shipping info (see paragraph 30). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

The Applicant argues that Sheddan does not teach displaying confirmation of payment received. The Examiner answers that Sheddan teaches verifying and confirming an order (see paragraph 30). Therefore, contrary to Applicant's argument, Sheddan teaches Applicant's claimed limitation.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

/DANIEL LASTRA/
Examiner, Art Unit 3688
January 24, 2009